



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Joshua J.D. MARTIN et al.

Title: METHOD OF CONDUCTING AN ELECTRONIC  
ROLLING AUCTION PERMITTING THE  
AUCTION SPONSOR TO MAKE CHANGES TO  
THE AUCTIONED ITEM

Appl. No.: 09/920,323

Filing Date: 08/02/2001

Examiner: A. Fischer

Art Unit: 3627

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF, AND REVISED  
APPEAL BRIEF**

Mail Stop APPEAL BRIEF-PATENTS  
Board of Patent Appeals and Interferences  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

This revised Appeal Brief is being filed in response to a Notice of Non-Compliant Appeal Brief dated 21 February, 2008.

**I. REAL PARTY IN INTEREST**

GXS, Inc. is the real party in interest.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants are unaware of any related appeals or interferences.

**III. STATUS OF CLAIMS**

Claims 1-23 were originally pending in this application. A restriction requirement was issued by the PTO on February 10, 2004, between Group 1 (Claims 1-6, 11-16 and 21) and Group 2 (Claims 7-10, 17-20, 22 and 23. In a reply to the restriction requirement, the claims of Group 1 were elected by Appellants. In a first Office Action dated May 7, 2004,

claims 1-6, 11-16 and 21 were rejected under 35 U.S.C. Section 101, Section 112, 2<sup>nd</sup> paragraph, Section 102(b), and Section 102(e). In a reply to the first Office Action, claims 1, 2, 4, 5, 11-16 and 21 were amended, and claims 24-26 were added. A Supplemental Amendment and Reply was also filed soon thereafter, whereby claims 2, 12 and 14 were amended in order to improve readability. In a second, final Office Action dated February 18, 2005, claims 1-6, 11-16 and 21-23 were rejected under 35 U.S.C. Section 112, 2<sup>nd</sup> paragraph, Section 102(e), Section 102(b), and Section 103(a). In a reply to the second Office Action, claims 1, 3-5, 11-16, 21 and 24-26 were amended, and 'withdrawn' claims 7-10, 17-20, 22 and 23 were canceled. An Advisory Action was issued on June 1, 2005 by the PTO. In response, an RCE and an Amendment were filed, whereby claims 1, 11 and 21 were amended by Appellants. A non-final Office Action was mailed on August 24, 2005 by the PTO, whereby claims 21 and 26 were rejected under 35 U.S.C. Section 101, claims 24-26 were rejected under 35 U.S.C. Section 112, 2<sup>nd</sup> paragraph, and claims 1-6, 11-16, 21 and 24-26 were rejected under 35 U.S.C. Section 103(a). A response to that Office Action was filed by Appellants on December 23, 2005. A final Office Action was mailed on March 9, 2006, whereby the claims were finally rejected under 35 U.S.C. Section 102(e) and 103(a). A Notice of Appeal was filed by Appellants on June 9, 2006. Claims 1-6, 11-16, 21 and 21 are presently pending for appeal.

#### **IV. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final rejection made in the final Office Action dated March 9, 2006.

#### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Claims 1, 11 and 21 are independent claims. Specifically, claim 1 recites:

*A computer implemented method that refreshes an on-going electronic auction at a server, comprising the steps of:*

*determining whether a sponsor determined auction parameter generated by a sponsor of the auction has been changed while the auction is on-going, the sponsor*

*determined auction parameter not including bid information derived from an input received from any auction participant; and*

*automatically generating a communication that causes a refreshing of a representation of the auction at a browser of an auction participant when it is determined that the sponsor determined auction parameter has been changed.*

Support for the ‘determining’ step may be found in paragraph 0044, the last sentence, which states that “the present invention is directed to the situation when the event has been posted, but the auction sponsor wishes to change an auction parameter.” Paragraph 0049 describes the determining of one or more items of auction information that are to be changed. Paragraph 0050 describes a scenario whereby a server side component generates a communication to notify participants of an auction parameter change.

Support for the ‘automatically generating’ step may be found in paragraph 0051, which states that “Receipt of this communication [information indicating that auction information has changed] invokes a method to initiate a fresh of the entire auction web page. See also paragraph 0052, which states refreshing of the auction web page is performed if the determination is that a change has been made to an auction parameter.

Independent claims 11 and 21 recite similar features, as a computer program product (claim 11) and as a system (claim 21).

In more detail, the present invention is directed to a method (and apparatus and computer program product) of facilitating an auction via the world wide web, and specifically to a method for conducting an electronic rolling auction wherein the auction sponsor is able to make changes to the items being auctioned while the auction is underway.

As stated in paragraph 0011 of the specification, “the present inventors have realized that electronic auctions may be improved if an auction system enables auction sponsors to modify one or more of the parameters of the auction while the auction is underway. By enabling auction sponsors to modify the auction item database and providing electronic notifications to participating bidders when such changes are made to the auction, the present invention permits auction sponsors to react dynamically to information and insight provided by bidder responses in order to offer a combination of items, quantities, payment, delivery, pricing and other parameters that will yield the best available deal for the auction sponsor.”

Also, as explained in paragraph 0042 of the specification, “in response to the selection of the request to create an auction, the sponsoring client 10A is prompted to create an event for the auction and input the auction parameters to create the auction parameter objects. The auction parameters include all of the details regarding a product that the sponsoring client 10A is seeking to purchase or to sell. These details include, for example, the name of the auction, the start and end time of the auction, the name of the product, a description of it, a target price, the amount to be purchased or sold, the timing for a contract and delivery of the product, other terms and conditions, and the currency type. The details of the auction may further include several bidding options, such as the lot type, the reserve price, the minimum number of bidders for starting the auction, the type of bid feedback and the amount of bid increments or decrements. In addition, the details of the auction may include extensions, as well as activity and inactivity rules, and the direction of the auction, and any other information that may be useful to the participating client 10 when submitting a bid. In addition, the event may include attachments, such as figures, drawings, pictures or text, which help to describe the product more completely. The event may also include a list of participating clients 10 from which the sponsoring client 10A wishes to solicit bids. The list of participating clients 10 may be considered part of or separate from the creation of the event. Each or selected ones of these auction parameters may be designated as changeable, e.g., can be changed after the auction event is commenced.”

The changeability of auction parameters after an auction has commenced is featured in the presently pending independent claims.

Dependent claims 24-26 each recite:

*wherein the sponsor determined auction parameter comprises one of a details of a product being auctioned, bidding options, or attachments that describe the product being auctioned.*

Support for the features recited in dependent claims 24-26 may be found in paragraph 0041 of the specification.

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to be reviewed on appeal are: a) the final rejection of claims 1-6, 11-16, 21 and 24-26 under 35 U.S.C. § 102(e) as being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0246266 to Stefanovic et al. ("Stefanovic"); and b) the final rejection of claims 1-6, 11-16, 21 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0220867 to Goodwin et al. ("Goodwin").

**VII. ARGUMENT**

The rejections of claims 1-6, 11-16, 21 and 24-26 under 35 U.S.C. § 102(e) and § 103(a) should be withdrawn because: (a) Stefanovic does not disclose, teach or suggest the claimed invention (see subsection A, below); and (b) Goodwin is not prior art with respect to this application (see subsection B, below).

**A. § 102(e) and § 103(a) Rejection of Claims 1-6, 11-16, 21 and 24-26: Stefanovic****i. Claims 1-6, 11-16, 21 and 24-26:**

With respect to the rejections made based on Stefanovic, the final Office Action (mailed March 9, 2006) asserts that Stefanovic discloses automatically refreshing an auction parameter, which allegedly corresponds to "lot number or identification number." The Office Action then refers to paragraph 0064 of Stefanovic., and states that "It will be understood that the lot number or lot identification information might be automatically refreshed to the screen of the site terminal (3) as the auction progress."

In reply, while Stefanovic describes the refreshing of a lot number or a lot identification information at a site terminal, this refreshing does not change the contents of the lot number or the lot identification information during an on-going auction (at least there is no disclosure or suggestion of doing this in Stefanovic). Rather, it appears that once an auction has completed, the sponsor can then update information at respective buyer site terminals in accordance with a next item to be auctioned off.

In contrast, each of the presently pending independent claims 1, 11 and 21 recites a step of determining whether a sponsor determined auction parameter has been changed while the auction for an item is on-going. Thus, unlike Stefanovic which appears to only allow a change in lot number or identification number once an auction has completed, the presently claimed invention allows for a sponsor determined auction parameter to be changed and then reflected at respective browsers of auction participants while the same auction is on-going.

With respect to the detailed comments provided in the Office Action with regards to the Applicant being his/her own lexicographer, the words recited in the claims should be given their ordinary and accustomed meaning. Thus, the term “on-going” means that a current auction is on-going, and has not yet ended. This is the ordinary and accustomed meaning of “on-going.” Thus, the first step of independent claims 1, 11 and 21 covers a case whereby a sponsor determined auction parameter has been changed while an auction is on-going, and not after the current auction has ended. The second step of independent claims 1, 11 and 21 then automatically generates a refreshing of an auction representation at an auction participant’s browser when the sponsor determined auction parameter has been determined to have changed during an on-going auction. As is clear from the comments provided above, Stefanovic does not disclose, teach, suggest such features.

Since Stefanovic does not disclose, teach, suggest the above-mentioned features, the presently pending independent claims 1, 11 and 21, as well as their respective dependent claims, are not anticipated by and are not obvious over Stefanovic.

In light of the foregoing, the § 102(e) and § 103(a) rejections of claims 1-6, 11-16, 21 and 24-26 should be reversed.

**ii. Claims 24-26**

Still further, dependent claims 24-26 (which depend from independent claims 1, 11 and 21, respectively) provide further details of the sponsor determined auction parameter, which comprises one of details of a product being auctioned, bidding options, or attachments that describe the product being auctioned. The Office Action equates Stefanovic’s lot identification number as allegedly corresponding to the claimed sponsor determined auction parameter. While Figure 5 of Stefanovic shows a lot identification for an auction, even if

such a lot identification may help identify an item for auction, that lot identification does not change during the auction. Once a new item for auction appears on the display, a new lot identification is provided, but this is done after the current auction has completed.

Since Stefanovic does not disclose, teach, suggest the above-mentioned features of dependent claims 24-26, those claims are not anticipated by and are not obvious over Stefanovic for these additional reasons, beyond the reasons given above in section VII.)A.)i.) for their respective independent claims.

**B. § 103(a) Rejection of Claims 1-6, 11-16, 21 and 24-26: Goodwin**

Goodwin was filed on February 24, 2003, and is a Continuation-In-Part (CIP) of patent application serial number 09/928,109, filed on August 10, 2001. Please note that the present application has a filing date of August 2, 2001, and thus Goodwin is not prior art with respect to the present application. Accordingly, the § 103(a) rejection of claims 1-6, 11-16, 21 and 24-26 over Goodwin is improper.

**CONCLUSION**

For the aforementioned reasons, claims 1-6, 11-16, 21 and 24-26 are allowable over the cited art of record. As a result, each of the Examiner's grounds for rejection should be reversed.

Respectfully submitted,

Date February 27, 2008

By Phillip J. Articola

Customer Number: 22428  
FOLEY & LARDNER LLP  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143

Phillip J. Articola  
Registration No. 38,819  
Attorney for Appellants

Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HERewith, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HERewith, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.

**VIII. CLAIMS APPENDIX**

A listing of the pending claims is set forth below, with status identifiers included:

1. (Previously Presented) A computer implemented method that refreshes an on-going electronic auction at a server, comprising the steps of:

determining whether a sponsor determined auction parameter generated by a sponsor of the auction has been changed while the auction is on-going, the sponsor determined auction parameter not including bid information derived from an input received from any auction participant; and

automatically generating a communication that causes a refreshing of a representation of the auction at a browser of an auction participant when it is determined that the sponsor determined auction parameter has been changed.

2. (Previously Presented) The method as defined in claim 1, wherein the determining step further comprises determining if an indicator has been set at the server to indicate that an auction parameter has changed.

3. (Previously Presented) The method as defined in claim 2, wherein the indicator determining step further comprises refreshing an updater object; and determining if the value in the refreshed updater object indicates that an auction parameter has changed.

4. (Previously Presented) The method as defined in claim 1, wherein the determining step further comprises receiving a communication from the server indicating that an auction parameter has changed.

5. (Previously Presented) The method as defined in claim 4, wherein the determining step further comprises the step of determining if the communication is from an authorized party.



6. (Original) The method as defined in claim 1, further comprising the step of displaying a notice that web page content has been changed.

7-10. (Cancelled)

11. (Previously Presented) A computer program product having computer readable code embodied on a computer readable medium that when executed by a computing system refreshes an on-going electronic auction, the computer readable code comprising:

code that determines whether a sponsor determined auction parameter generated by a sponsor of the auction has been changed while the auction is on-going, the sponsor determined auction parameter not including bid information derived from an input received from any auction participant; and

code that generates a communication that automatically causes a refreshing of a representation of the auction at a browser of an auction participant when it is determined that the sponsor determined auction parameter has been changed.

12. (Previously Presented) The program product as defined in claim 11, wherein the code that determines further comprises code for determining if an indicator has been set at the server to indicate that an auction parameter has changed.

13. (Previously Presented) The program product as defined in claim 12, wherein the code that determines if the indicator has been set comprises code for refreshing an updater object; and determining if the value in the refreshed updater object indicates that an auction parameter has changed.

14. (Previously Presented) The program product as defined in claim 11, wherein the code that determines further comprises code that receives a communication from the server indicating that an auction parameter has changed.

15. (Previously Presented) The program product as defined in claim 14, wherein the code that determines further comprises code for determining if the communication is from an authorized party.

16. (Previously Presented) The program product as defined in claim 11, further comprising code that displays a notice that web page content has been changed.

17-20. (Cancelled)

21. (Previously Presented) A system that refreshes an on-going electronic auction, comprising:

a computer server component that determines whether a sponsor determined auction parameter generated by a the sponsor of the auction has been changed while the auction is on-going the sponsor determined auction parameter not including bid information derived from an input received from any auction participant; and

wherein the computer server a component generates a communication that automatically causes a refreshing of a representation of the auction at a browser of an auction participant when it is determined than the sponsor determined auction parameter has been changed.

22-23. (Cancelled)

24. (Previously Presented) The method as defined in claim 1, wherein the sponsor determined auction parameter comprises one of a details of a product being auctioned, bidding options, or attachments that describe the product being auctioned.

25. (Previously Presented) The computer program product as defined in claim 11, wherein the sponsor determined auction parameter comprises one of a details of a product being auctioned, bidding options, or attachments that describe the product being auctioned.

26. (Previously Presented) The system as defined in claim 21, wherein the sponsor determined auction parameter comprises one of a details of a product being auctioned, bidding options, or attachments that describe the product being auctioned.

**IX. EVIDENCE APPENDIX**

None.

**X. RELATED PROCEEDINGS APPENDIX**

Appellants are unaware of any related appeals, interferences, or decisions rendered by a court or the Board.